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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,430	10/08/2003	Tetsuya Kubo	33023US1	7140
116	7590	06/02/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			LE, DANH C	
		ART UNIT		PAPER NUMBER
				2683

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/681,430	KUBO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANH C LE	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 08 October 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 10-14 and 16-19 is/are allowed.  
 6) Claim(s) 1-3,5,6,8 and 15 is/are rejected.  
 7) Claim(s) 4,7 and 9 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 08 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/8/03</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Priority***

1. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 10/08/03 has been considered by the examiner and made of record in the application file.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-19 are rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 6,728,558 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the U.S. Patent No. 6,728,558 encompass claim 1-19 of the present application (i.e. claims 1-19 are broader than the claims in the U.S. Patent 6,728,558).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-3, 5, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weadon (US 6,226,501) in view of Johnson (US 6,463,262).**

As to claim 1, Weadon teaches the portable telephone apparatus (figure 4B and col.4, lines 10-col.5, line 36) comprising:

means for radio communication, said means for radio communication including a transmitter and a receiver;

a body, said body including a plurality of first key entry means; and

a cover pivotally connected to said body, said cover having one or more second key entry means, each of said one or more second key entry means capable of activating a corresponding one of said first key entry means when said cover is in a closed position.

Weadon fails to teach a cover slidably connected to said body. Johnson teaches a cover slidably connected to said body (figure 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Johnson into the system of Weadon in order to provide a tactile improvement for the user which he can apply substantial the same force to one of the parts to move it a certain distance relative to other, irrespective of its starting position.

As to claim 2, Weadon teaches the portable telephone apparatus of claim 12, further comprising cover opening/closing state detecting means, wherein at least one operation is performed when said cover opening/closing state detecting means detects that said cover is opened or closed. Weadon fails to teach the cover is slid opened or slid closed. Johnson teaches the cover is slid opened or slid closed (col.6, lines 6-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Johnson into the system of Weadon in order to provide system enhancement performance of the radiotelephone having a primary keypad and a movable flip cover that contains a secondary keypad.

As to claim 3, Weadon teaches the portable telephone apparatus of claim 12, said body further including a first microphone and said cover further including a slot which functions as a second microphone (for the skill in the art the slot may replace by a second mouthpiece).

As to claim 5, Weadon teaches the portable telephone apparatus (figure 4B and col.4, lines 10-col.5, line 36) comprising:

means for radio communication, said means for radio communication including a transmitter and a receiver;

a body, said body including a plurality of first key entry means;

a cover moveably connected to said body, said cover having a plurality of second key entry means, each of said second key entry means capable of activating a corresponding one of said first key entry means when said cover is in a closed position; and

cover opening/closing state detecting means; wherein at least one operation is performed when said cover opening/closing state detecting means detects that said cover is opened or closed, and further wherein said at least one operation is programmable by a user.

Weardon fails to teach a cover slidably connected to said body. Johnson teaches a cover slidably connected to said body (figure 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Johnson into the system of Weardon in order to provide a tactile

improvement for the user which he can apply substantial the same force to one of the parts to move it a certain distance relative to other, irrespective of its starting position.

As to claim 8, the combination of Weadon and Johnson teaches the portable telephone apparatus of claim 5, wherein in said cover is slidable connected to said body (Johnson, figure 3).

**5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weadon and Johnson in view of Norman (US 6,073,027).**

As to claim 6, Weadon and Johnson teaches a portable telephone apparatus according to claim 5. Weadon and Johnson fails to teach the cover opening/closing state detecting means including a magnetic and a means for detecting said magnet. Norman teaches the control means perform call release operation when said cover opening/closing state detecting means has detected closing of the sliding cover from the open state (col.7, line 62-col.8, line 5) and said magnet comes in close proximity to said lead switch to turn on/off said lead switch when the cover is closed (col.5, line 56, col.6, line 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Norman into the system of Weadon in order to provide enhanced system performance of the telephone having a primary and secondary keypad.

**6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weadon and Johnson in view of Roeder (US 5,491,745).**

As to claim 15, Weadon teaches the portable telephone apparatus comprising:

means for radio communication, said means for radio communication including a transmitter and a receiver;

a body, said body including a plurality of first key entry means; and

a cover connected to said body, said cover having a plurality of second key entry means capable of activating a corresponding one of said first key entry means when said cover is in a closed position, wherein some portion of said first key entry means can be registered with a corresponding phone number, each of said first entry means being pre-registered with a corresponding key input operation signal,

cover opening/closing state detecting means, wherein at least one operation is performed when said cover opening/closing state detecting means detects that said cover is opened or closed.

Weardon fails to teach a cover slidably connected by the body and detects the cover is slid opened. Johnson teaches a cover slidably connected by the body and detects the cover is slid opened (col.6, lines 6-19). The combination of Weardon and Johnson fails to further teach when one of said some portion of said first key entry means is activated shorter than a predetermined period, said key input operation signal is inputted, and when one of said some portion of said first key entry means is activated longer than the predetermined period, said corresponding number is connected.

Roeder teaches if one of said some portion of said first key entry means is activated for more than a first time period, the corresponding phone number is displayed on said display, and still further wherein, if said one of said some portion of said first key entry means is activated for more than a second time period, said corresponding phone

number is connected (col.6, line 24-col.8, line 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Roeder into the system of Weadon and Johnson in order to provide system enhancement performance of the radiotelephone having a primary keypad and a movable flip cover that contains a secondary keypad.

***Allowable Subject Matter***

Claims 4, 7, 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10-14, 16-19 are allowed.

As to claims 4, 7, 9 , the teaching of above prior arts either alone or in combine fails to teach the portable telephone apparatus of claim 5, further comprising a display, wherein some portion of said first key entry means can be registered with a corresponding phone number, and further wherein, if one of said some portion of said first key entry means is activated for more than a first time period, the corresponding phone number is displayed on said display, and still further wherein, said one of said some portion of said first key entry means is activated for more than a second time period, said corresponding phone number is connected or he portable telephone apparatus of claim 5, wherein said at least one operation is programmable by a user.

As to claims 10, 16, the teaching of above prior arts either alone or in combine fails to teach a cover slidably connected to said body, said cover having a plurality of second key entry means capable of activating a corresponding one of said first key

entry means when said cover is in a closed position, wherein some portion of said first key entry means can be registered with a corresponding phone number, each of said first entry means being pre-registered with a corresponding key input wherein, when one of said operation signal, and further some portion of said first key entry means is activated shorter than a predetermined period, said key input operation signal inputted, and when one of said some portion of said first key entry means is activated longer than the predetermined period, said corresponding number is connected.

Dependent claims 11-14, 17-19 are allowable for the same reason.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C LE whose telephone number is 571-272-7868. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2683

danh

DANH C. LONG LE  
PATENT EXAMINER